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BAKER BOTTS L.L.P.  
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EXAMINER
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RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3689

NOTIFICATION DATE	DELIVERY MODE
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08/20/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/659,465	<b>Applicant(s)</b> STASHLUK ET AL.	
	<b>Examiner</b> Dennis Ruhl	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/23/09 has been entered.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11,13-27 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because there is not tie to a particular machine. The step of providing "one or more computer systems" and reciting that the computer systems provide return services to a plurality of customers is not seen as a step that is being executed by a particular machine. At best this would be use of a generic type of machine (computer system) for insignificant extra solution activities. The recitation to "using" one or more computer systems to determine a transaction specific shipping destination, this is claiming that a particular machine is doing the determining of the shipping destination. A person can manually retrieve or look at data that allows the person to make the determination of which destination is closest to the customer. The claim does not exclude a person from actually conducting this step by simply using a computer to look at some stored data. That is not a sufficient tie to a particular machine that would serve to render the claim as statutory. The same is true for the other step that is recited as "using" one or more computer systems to provide a return label to the customer. This can also be done by a person

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and at best would be considered insignificant extra solution activities due to it just being a step of providing something, similar to the mere output of data or the transmission of data, both considered to be directed to insignificant extra solution activities. The step of using the postal service to transport the package is not tied to any machine at all. The same is true for the step of “holding”, there is no tie to any machine at all. The dependent claims are not seen as providing a remedy for this problem and are considered to be non-statutory as well. With respect to claim 7, it is seen as being directed to insignificant extra solution activities because the act of acquiring data from the Internet is nothing more than the mere transmission or output of data, where the main or central steps to the method are not tied to a particular machine.

Further, applicant’s method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no eligible transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11,13-27, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,20, the language of “the one or more computer systems providing return services to a plurality of customers” is considered to be indefinite. What does this mean? What is meant by providing return services? To provide something is simply making that something available, so it is not even clear if there is any step being executed here, other than just having a computer available that can provide whatever “return services” is. Applicant appears to be relying on this language as part of the argument that the claim is statutory under 101, but it is not even clear as to what this language is really reciting as far as a step goes, and as far as what is meant by “return services”. For the term “the processing center” at line 7, there is no antecedent basis for this term. What processing center does this refer to? What computer systems have previously been recited that are “associated” with “the processing center”? Is this the same as the “one or more computer systems” that is provided at line 4 that are not recited as being associated with a processing center but are recited as being associated with the returns provider? This is not clear.

For claim 10, it is not clear as to what is meant by reciting that “data” is electrical circuitry. Data is data, and data cannot be considered as electrical circuitry to a reasonable person. How can data, which is information representative of something

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(numbers, text, figures, etc.), be electrical circuitry? This does not seem to make any sense.

For claim 25, there is no antecedent basis for “the carrier center” that is near the returns center. The same is true for the “shipping carrier service”. Applicant has amended independent claim 20 and has canceled the portion of the claim that recites a carrier center, shipping carrier service, etc.. Claim 25 has not been amended accordingly and is referring to claim language that was canceled from claim 20. Claim 25 is confusing because claim 20 makes no mention of the elements claimed in claim 25. It is not clear what claim 25 is reciting due to lack of antecedent basis for most of what is claimed.

For claim 26, there is no antecedent basis for “the carrier station” near the returns center.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-11,13-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (6536659) in view of Junger (6085172).

For claims 1,3,13,20,21,23,25, Hauser discloses a method and system for enabling the return of products by sending a return to a return center (service provider). A customer is provided with a bar coded return label as claimed. See column 3, line 43 to column 4, line 35. The return label may be provided to the customer via computers and is received in electronic form by the customer for printing. A computer system is provided as claimed that provides "return services" to a number of customers. There is destination address on the return label as claimed. The label has bar coded data that is relevant to the return of the merchandise (identification of the transaction) and includes the merchant identification. Also, with respect to reciting what the data is that is on the label, unless the data is somehow used in a further method step of the claim in a functional manner, this is directed to non-functional descriptive material (in a similar sense to a printed matter issue for a return label as an article). The claim will not be rendered patentable by the mere recitation to non-functional descriptive material. The language that recites the package is held "for pick up by the returns provider" is noted as being language directed to the intended purpose of the "holding" step. All that is claimed in the last two lines of the claim is that the package is received, which is found in Hauser. This satisfies what is claimed.



Not disclosed is that a transaction specific shipping destination (of a postal center) is determined (using the computer system), where the destination is the closest to the customer. Also not disclosed is using a postal service to transport the package to the "postal center" closest to the customer. With respect to the term "postal center", this language is interpreted to be simply a "center" as the term "postal" does not appear to define any structure to the center. Also, commensurate with the disclosed invention in the specification, the location that is closest to the customer is disclosed as including a regional return center. See the instant specification on page 8. Reciting a "postal center" is not seen as any different from claiming just a "center". Junger discloses a merchandise return system that has regional return centers that merchandise is returned and shipped to as opposed to having only one return center for the entire county. See figure 1. Product returns are disclosed as being shipped to a regional location (claimed postal center) prior to potentially being shipped to another final destination. See column 3, lines 58-64 as an example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hauser with multiple regional return centers as is well known in the art, so that merchandise can be shipped to a regional return center that is closest to the customer for processing prior to being sent to the final destination. This feature is known in the art as evidenced by Junger and is disclosed as being desirable for cost savings and logistical reasons. As stated previously, the "holding" step is satisfied by the prior art receiving a package at the shipping destination. The step of determining the closest shipping destination to the customer is considered to be something that flows from the idea of having regional

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return centers that serve specific geographic locations. When one of ordinary skill in the art is using a regional return center to receive packages from customers, it follows that one would naturally need to determine what regional return center the customers package should be sent to. In other words, when a customer is returning a package, you would need to determine where the customer is located so you can ship the package to the regional return center that is closest to the customer and that serves that region. That is the purpose of having a regional return center.

For claim 20, the recitation regarding the notification is directed to non-functional descriptive material. Unless the notification is acted upon in a further method step it will not serve as a limitation. Also in Hauser it is disclosed that the return label and the return can be pre-authorized.

For claim 2, this claim is directed to non-functional descriptive material. Reciting the name of the return provider is just descriptive language that does not serve as a further structural limitation.

For claim 4, as this claim is best understood by the examiner, the address on the return label complies with the USPS specifications; otherwise, the packages would never be able to be mailed.

For claim 5, see column 2, lines 17-23 where the claimed limitation is disclosed.

For claim 7, Hauser discloses that the return label can be received via email or via the Internet. See column 4, lines 30-35 and/or column 4, lines 1-15. When using email to receive a return label, this is using the Internet as claimed.

For claim 9, see column 4, lines 16-35.

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For claim 10, claiming that the data is electrical circuitry and that the data is an RFID tag is indefinite and it is not know what the scope of this claim is. Data is data and Hauser discloses data on the return label. To this extent Hauser satisfies what is claimed.

For claims 11,14-19, this claim is directed to non-functional descriptive material. Also, with respect to reciting what the data is that is on the label, unless the data is somehow used in a further method step of the claim in a functional manner, this is directed to non-functional descriptive material (in a similar sense to a printed matter issue for a return label as an article). The claim will not be rendered patentable by the mere recitation to non-functional descriptive material.

For claim 26, reciting that the carrier station is a “regional bulk mail center” does not change the fact that the package is shipped to a destination, which is disclosed by Hauser in view of Junger. What you call or name the destination does not distinguish over the prior art. The return destination (regional return center) is a location of some kind and can fairly be considered a carrier station and/or a bulk mail center or a postal center. The destination can also be considered as a building, a structure, a return facility, etc., in other words, what you call the destination does not change the fact that all that is recited is a destination.

For claim 6, not disclosed is that the return label is attached to an invoice. Hauser discloses that the return label can be included with the merchandise when it is initially purchased, see column 2. The minor difference of reciting that the return label is attached to an invoice is considered to be obvious to one of ordinary skill in the art.

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One of ordinary skill in the art would understand that the return label could simply be placed in the container that the merchandise is sold in, or can be attached to an invoice that would be included with the merchandise. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the return label to an invoice. This involves no more than ordinary skill in the art.

For claims 8,22,27, not disclosed is the use of the postal code, and the assessing of shipping charges. The examiner again takes "official notice" of the fact that it is known in the art of shipping packages that an item can be shipped and after shipping has occurred, the shipping charges are assessed. This is known in the art as "reverse manifesting", where the shipping charges are assessed after the package has been received at its destination. Applicant has not challenged this official notice so the asserted fact is now taken as fact for the record. It would have been obvious to one of ordinary skill in the art at the time the invention was made to assess shipping charges as claimed by using "reverse manifesting" and assessing the charges once the package is at its destination. With respect to the use of a postal code to assess the shipping charges, this is just using the zip code of a return address. This is very well known in the art and one of ordinary skill in the art would have found it obvious to use a postal code (e.g. zip code) to assess shipping charges. The origin zip code can be used to identify where the package originated from, and the destination zip code can be used to figure out where it was shipped to, then the shipping can be determined.

For claim 24, the machine readable data is used to determine if the merchant will accept the return after it has been received at the return center. After this determination

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is made, at some point it would have been obvious to one of ordinary skill in the art to inform the customer of information regarding the return. This could be as simple as a notification to the customer that the items have been received.

9. Applicant's arguments filed 6/23/09 have been fully considered but they are not persuasive.

With respect to the 101 rejection, the current rejection of record addresses the amended claim scope, which applicant is referred to. The rejection of record addresses applicant's arguments. The only tie or use of a machine (not a particular machine, just a computer system in a generic sense) is for insignificant extra solution activities. This can be the mere transmission of the label for printing or the mere sending of a message. These are limitations directed to insignificant extra solution activities and does not constitute a sufficient tie. Also, the mere recitation to a computer in a generic sense is not a particular machine that has been programmed to do anything at all. That is not a tie to a "particular" machine but a tie to a general computing device. The tie to the particular machine must be a tie that involves the central steps to the method and not simply steps that include the mere transmission of data (return label) or the printing of the return label, or making available a computer system (providing step).

For the 112,2<sup>nd</sup> rejection, applicant did not address claim 10 in any manner. There was no amendment to claim 10 and no argument presented that traversed the 112 rejection. The new 112 rejections of record are necessitated by applicant's amendment.

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With respect to the prior art traversal it is not persuasive. The new grounds of rejection applied to the claims renders applicant's arguments as moot. Applicant has amended the claims to recite the shipping of the package to a destination closest to the customer. The claim has been amended to recite similar subject matter to that of pending claim 13 that recites multiple return destinations. The newly amended claim language reads on having a regional return center. This was addressed in the last office action in the 103 rejection of Hauser in view of Junger. Applicant has failed to address Junger in the recent arguments and has only addressed Hauser, so there is nothing for the examiner to respond to as the arguments are moot based on a new grounds of rejection applied to the claims. Applicant has amended the claims to recite what Junger teaches and the rejection of record addresses the new claim scope.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/  
Primary Examiner, Art Unit 3689